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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,515	09/30/2003	Jacqueline Evynne Breuninger Buskop	1207.01A	6098

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EXAMINER	
REESE, DAVID C	
ART UNIT	**PAPER NUMBER**
3677	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/675,515	BUSKOP, JACQUELINE EVYNNE BREUNINGER	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

[1] Claims 1-14 are pending.

Drawings

[2] New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings should exemplify more detail and better quality, specifically that of the LED light/prongs, so that paramount attributes and specifications of the claimed invention are more efficiently presented, and thus differentiated from other art. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

[3] The abstract of the disclosure is objected to because minor grammatical issues in the third line as it appears that certain words have spaces between letters. Correction is required. See MPEP § 608.01(b).

[4] The disclosure is objected to because of the following informalities:

Minor grammatical and formatting issues, line 5 on page 3 for example, "has a lot of appear..." is not grammatically correct. Examiner asks applicant's cooperation in maintaining that the entire specification is void of similar issues.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 1-5, 7-13 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Dichtel, US- 5,146,768, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Dichtel is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Dichtel teaches of an earring apparatus comprising:

a. at least one earring clip (12) with back side (20) and front side (22) for engaging a non-pierced ear;

b. at least one hook (30) secured to said earring clip (12);

c. at least one edible food item removably secured to said hook (col. 3 line 16, "an ornament may be slideably suspended...but cannot be slipped off of pin 12 for replacement, except by temporary removal of bead 20 or 22"), wherein said edible food item is selected from the group: a fruit, a vegetable, and combinations thereof. (Examiner takes official notice that it is old and well known, as well as an obvious matter of art recognized equivalence, to a person having ordinary skill in the art at the time the invention was made to attach an edible food item. In addition, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).*

Re: Claim 2, wherein at least one hook (30) comprises at last two hooks (30,28) connected in series.

Re: Claim 3, wherein said earring clip further comprises an LED light that automatically lights said hook in dim light (Examiner takes official notice that it is old and well known, as well as obvious, to a person having ordinary skill in the art at the time the invention was made to attach an ornament such as an LED light onto a jewelry item).

Re: Claim 4, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Examiner takes official notice that it is old and well known,

as well as obvious, to a person having ordinary skill in the art at the time the invention was made to attach an ornament such as an LED light onto a jewelry item).

Re: Claim 5, wherein said hook is between 1.5 inches and 3 inches in overall length (Figs. 1-4h).

Re: Claim 7, wherein the edible food item (Examiner takes official notice that it is old and well known, as well as an obvious matter of art recognized equivalence, to a person having ordinary skill in the art at the time the invention was made to attach an edible food item. In addition, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947))* is selected from the group: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruitsfruits with similar sturdy yet pierce-able skins, and vegetables with similar sturdy yet pierce-able skins.

As for Claim 8, Dichtel teaches of an earring apparatus comprising:

a. at least one earring clip (12) for engaging a non-pierced ear;

b. at least one hook (30) secured to said earring clip (12);

c. at least one chewy candy item removably secured to said hook (col. 3 line 16, "an ornament may be slideably suspended...but cannot be slipped off of pin 12 for replacement, except by temporary removal of bead 20 or 22") (Examiner takes official notice that it is old and well known, as well as an obvious matter of art recognized equivalence, to a person having ordinary skill in the art at the time the invention was made to attach an candy item. In addition, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from

the prior art. *In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947))*, wherein said edible food item is selected from the group: a fruit, a vegetable, and combinations thereof.

Re: Claim 9, wherein said candy (Examiner takes official notice that it is old and well known, as well as an obvious matter of art recognized equivalence, to a person having ordinary skill in the art at the time the invention was made to attach an candy item. In addition, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947))* is selected from the group: soft licorice, soft raspberries, juicy fruits, and like soft candies.

Re: Claim 10, further comprising a line (18) wherein said hook (30) connects said line (18) near said earring clip (12) and a second hook (28) connects to said line (18) further from said earring clip (12) than said hook (28 below 30).

Re: Claim 11, wherein said earring clip further comprises an LED light that automatically lights said hook in dim light (Examiner takes official notice that it is old and well known, as well as obvious, to a person having ordinary skill in the art at the time the invention was made to attach an ornament such as an LED light onto a jewelry item).

Re: Claim 12, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Examiner takes official notice that it is old and well known, as well as obvious, to a person having ordinary skill in the art at the time the invention was made to attach an ornament such as an LED light onto a jewelry item).

Re: Claim 13, wherein said hook is between 1.5 inches and 3 inches in overall length (Figs. 1-4h).

Claim Rejections - 35 USC § 103

[7] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[8] Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dichtel, US- 5,146,768, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 6 and 14, Dichtel teaches of the above claims.

The difference between the claim and Dichtel is the claim recites: that the hook has at least a first and second prong. It would have been an obvious matter of art recognized equivalence to replace the rings (analogous with the term hooks) with hooks with prongs, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose that is not already understood by those skilled in the art. Also, note that those of ordinary skill in the art would appreciate that a modification such as a mere change in shape of a prior art device is a design consideration within the skill of the art, since in the instant case the

two shapes serve the same utility in sustaining an ornament or item onto the earring. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Conclusion

[9] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of jewelry item; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR

ROBERT J. SANDY
PRIMARY EXAMINER